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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/080,475 | 02/22/2002 | Bhupendra K. Soni | GTI-1468 | 8518 |

33058 7590 07/26/2005

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| EXAMINER |
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SINES, BRIAN J

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| ART UNIT | PAPER NUMBER |
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1743

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,475

Applicant(s)

SONI ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-13 is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☒ Claim(s) 2,3,5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

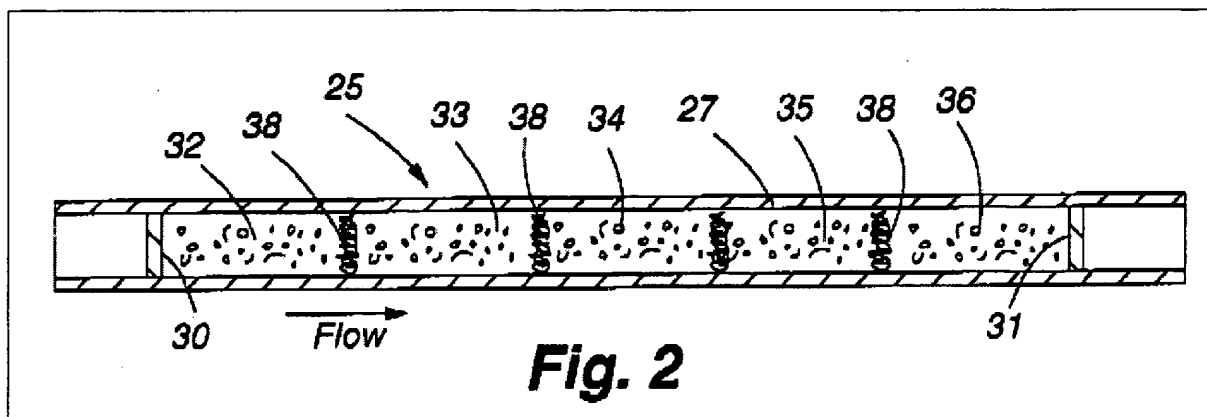
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Davison et al. (U.S. Pat. No. 5,922,974 A) (hereinafter “Davison”).

Regarding claims 1 and 4, Davison teaches an apparatus comprising: a transparent vessel (glass tube 27); sealable means (30 & 31); at least one sorbent material (e.g., molecular sieve resin material, i.e., carbosphere 33, for sorbing or trapping soil gas molecules); and a separation means (e.g., gas permeable barrier 38) (see 1, line 55 – col. 3, line 48; figures 1 – 3). The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114).



Allowable Subject Matter

Claims 2, 3, 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The cited prior art neither teach nor fairly suggest the further incorporation within the Davison apparatus a stirring means as recited in claim 2. The cited prior art neither teach nor fairly suggest the further incorporation within the Davison apparatus separation means comprising a dialysis bag as recited in claim 3. The cited prior art neither teach nor fairly suggest the further incorporation within the Davison apparatus a sealable means comprising at least one septum as recited in claim 6.

Claims 7 – 13 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claim 7, the cited prior art neither teach nor fairly suggest the claimed methodology for measuring release rates of contaminants in a at least one of a fast release mode and a slow release mode.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments filed 5/9/2005 have been fully considered, but they are not persuasive.

It is well settled that the United States Patent and Trademark Office (PTO) is obligated to give a disputed claim term its broadest reasonable interpretation, taking into account any enlightenment by way of definitions or otherwise found in the specification. See *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) ("[T]he PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution."). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993); *In re Barr*, 170 USPQ 330 (CCPA 1971). The applicant cannot read limitations set forth in the description into the claims for the purpose of avoiding the art. See *In re Sporck*, 155 USPQ 687 (CCPA 1967). The claims must be given their broadest reasonable interpretation consistent with the supporting description. See *In re Hyatt*, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). "The PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art." See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). "During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow." See *In re Zletz*,

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893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). “The PTO broadly interprets claims during examination of a patent application since the applicant may ‘amend his claim to obtain protection commensurate with his actual contribution to the art.’”(quoting *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)). See *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

Regarding claims 1 & 4, in comparison of these claims to the closest pertinent art, Davison still anticipates the invention as claimed. Davison does teach a functionally equivalent sealing means (30 & 31), which permits the flow of sample gas through the tube (27), but which also seals and retains the carbon molecular sieve material (e.g., carbosphere material 33) within the tube (see col. 2, line 6 - col. 3, line 12; figure 3). Although the apparatus, as taught by Davison, may not be what the applicant intends as their invention, the positively recited structural limitations of claims 1 & 4 still encompass, and thereby do not exclude, the apparatus disclosed by Davison. Contrary to the assertions of the applicant, the interpretation of the term “sealable” is not inconsistent in determining the meaning of the claims. The sealable means of the claimed invention can comprise a septum, as recited in claim 6, which does seal and also permits the passage of liquid samples through the septum. Similarly, regarding the Davison apparatus, the sealing means (30 & 31) unequivocally acts structurally as a seal, and also permits the passage of materials through the apparatus. In the broadest reasonable interpretation, these limitations are deemed equivalent. The claims are interpreted not only in view of the specification, but also as to how the claim limitations can be interpreted by a person of ordinary skill in the art, as indicated by the relevant applied art. The applicant further argues that the sealable feature refers to a closed system in which all of the materials within the reactor vessel

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are sealed therein. It should be noted that language reciting a sealable means configured to provide a perfect or complete seal, which does not permit the passage of any material, is not present in the claims, which would define the claimed apparatus over the Davison apparatus. (“Many of appellant’s arguments fail from the outset because, as the solicitor has pointed out, they are not based on limitations appearing in the claims.”). See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

The applicant further argues that the claimed apparatus and that of Davison are intended to be used in different manners, i.e., the Davison apparatus is used for collecting and analyzing soil gases which accumulate in the soil in the ground, etc. However, the applicant is advised that the instant claims are drawn to an apparatus. An intended use limitation for the claimed apparatus does not further delineate the structure of the claimed apparatus from that of the prior art. The Courts have held that a statement of intended use in an apparatus claim fails to distinguish over a prior art apparatus. See *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). As discussed above, Davison teaches all of the positively recited structural limitations of the claimed apparatus. Since these claims are drawn to an apparatus statutory class of invention, it is the structural limitations of the apparatus, as recited in the claims, which are considered in determining the patentability of the apparatus itself. Recited process or intended use limitations are accorded no patentable weight to an apparatus. Process limitations do not add patentability to a structure, which is not distinguished from the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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See *In re Casey*, 152 USPQ 235 (CCPA 1967); and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Courts have held that it is well settled that the recitation of a new intended use, for an old product, does not make a claim to that old product patentable. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

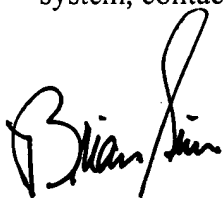
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Brian J. Sines". The signature is stylized with a large, looping initial "B" and a long, sweeping underline.